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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SMITH, KIMBERLY S

ART UNIT PAPER NUMBER

3644

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,000

Applicant(s)

COSENZA PAUL M.

Examiner

Kimberly S Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Response to Amendment

1. The Declaration filed on 10/23/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Arber reference (US Patent 6,353,939).
2. The Declaration submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Arber reference to either a constructive reduction to practice or an actual reduction to practice. The declaration states that the conception of the invention was disclosed to a third party between the period of July 2000-August 2000. The declaration further states that the concept was described to the Applicant's representative on February 13, 2001. The Arber reference's effective filing date is December 4, 2000 which post dates the Applicant's disclosure of conception and pre-dates the filing of the Applicant's application. As such, diligence must be established by evidence for the time period dating July 2000 until February 2001 (critical period). No such evidence has been presented. Diligence must be shown for the entire critical period. As the applicant has not presented facts such as sketches, blueprints, models, notebook entries, photographs or statement by witnesses regarding the critical time period, a showing of diligence has not been made and therefore the Declaration is ineffective in overcoming the Arber reference.

Drawings

3. The corrected or substitute drawings were received on 6/24/03. The drawing corrections are accepted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 5, 16, and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,353,939 to Arber (cited by applicant).

In reference to claim 1, Arber discloses a tick protection device comprising a set of protection elements (figure 1, elements 44), each protection element including: an elongate substrate with inner and outer surfaces; and respective inner and outer adhesive layers (column 5, line 36, where these features are inherent in double-sided tape). It has been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. At any rate, Arber does show a first adhesive layer that adheres the protection element upon a clothing surface near an opening (figure 1), and a second adhesive layer that impedes advancement of crawling insects toward clothing openings (column 3, lines 20-22).

In reference to claim 5, Arber discloses multiple protection elements (figure 1, element 44 in two locations), and the recitation that the elements are intended for multiple types of clothing openings does not differentiate the claimed apparatus from the prior art apparatus.

In reference to claim 16, Arber discloses the method of selecting a protection element from a set of protection elements with two adhesive layers (elements 44); exposing the adhesive surface of the first adhesive layer (inherent in the application of double-sided tape to a surface); applying the adhesive surface to a clothing surface (figure 1, element 44 applied to legging 10 adjacent the legging opening); and exposing the adhesive surface of the outer layer to impede advancement of insects toward a clothing opening (column 3, lines 20-24).

In reference to claim 22, Arber discloses the adherence of protection elements in regions of additional clothing openings (figure 1, where the adherence of element 44 is repeated for the second leg).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 6-9, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arber.

In reference to claim 2, Arber discloses a release sheet for the outer adhesive surface (column 3, lines 23-24) but does not specifically disclose a release sheet for the adhesive surface of the inner adhesive layer. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include release sheets on both the inner and outer surfaces, since it has been held that mere duplication of the essential working parts of the device involves only routine skill in the art.

In reference to claim 3, Arber discloses an outer release sheet. See discussion of claim 2 above.

In reference to claim 4, Arber discloses a release sheet on the outer adhesive surface (column 3, lines 23-24). It would have been obvious to include a release sheet mounted upon the adhesive surfaces of inner and outer adhesive layers, since it has been held that mere duplication of the essential working parts of a device and rearranging parts of an invention involves only routine skill in the art.

In reference to claim 6, Arber discloses a protection element sized and configured for adhering upon a clothing surface in the region of pant cuffs (figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to also include protective elements in the region of the waist band, shirt collar, shirt front, and shirt sleeves, since it has been held that rearranging parts of an invention involves only routine skill in the art. It would have also been obvious to modify the size of the protective elements for their positioning in different regions because a change in size is recognized as being within the level of ordinary skill in the art.

In reference to claims 7-9, Arber discloses a protection element pre-configured for length and shape (figure 1, where element 44 has been designed to fit around the leg), and it would have been obvious to modify the size of the protective elements for their positioning in regions of corresponding clothing openings because a change in size is recognized as being within the level of ordinary skill in the art.

In reference to claim 17, Arber discloses adhering the protection element around the lower leg (figure 1) but does not specifically state that the element is adhered below clothing

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openings. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the element below a clothing opening, since it has been held that rearranging parts of an invention involves only routine skill in the art.

In reference to claims 18 and 19, Arber teaches the claimed steps of removing inner and outer release sheets. See discussion of claims 2 and 3 above.

In reference to claim 20, Arber discloses delaying removal of the release sheet to expose the adhesive surface of the outer adhesive layer until protection is desired (column 5, lines 37-39, where the release sheet covers the adhesive prior to use).

In reference to claim 21, Arber teaches the claimed step of adhering the protection element in regions of various clothing openings. See discussion of claim 6 above.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arber in view of U.S. Patent No. 2,911,756 to Geary.

In reference to claims 10 and 11, Arber does not specify that the protection elements come in roll or sheet form.

Geary teaches that an adhesive insect-capturing material can come in roll or sheet form because both forms are suitable for providing the material in pre-determined sizes (column 3, lines 41-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the set of protection elements disclosed by Arber in the sheet or roll taught by Geary, since both forms are suitable for providing a pre-configured element.

9. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arber in view of U.S. Patent No. 5,381,557 to Luria et al.

In reference to claim 12, Arber does not disclose the claimed shield. Luria et al. teaches a shield portion (figure 1, element 13) extending outwardly from a plane of a substrate relative to and above a second, outer adhesive layer (element 2). Luria teaches that the motivation for using the shield is to protect the adhesive by sheltering it (column 4, lines 65-66). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an outwardly-extending shield, as taught by Luria, for the device disclosed by Arber, so as to protect the adhesive surface.

In reference to claim 13, Luria does not teach a shield portion integral with the substrate, but it would have been obvious to form the shield and substrate integrally since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

In reference to claim 14, Luria teaches a shield with the form of a curved outward extension of an edge portion of the substrate (figure 3). See discussion of claim 12 above.

In reference to claim 15, Luria teaches a shield comprising a protrusion (figure 3). See discussion of claim 12 above.

Conclusion


10. This is a RCE of applicant's earlier Application No. 10/083000. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S Smith whose telephone number is 703-308-8515. The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T Jordan can be reached on 703-306-4159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.


CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
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